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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,385	01/09/2001	Dirk Lenz	BEIERSDORF69	9792

7590 09/08/2004
Norris McLaughlin & Marcus PA
220 East 42nd Street
30th Floor
New York, NY 10017

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 7/14/04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-14 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-14 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some* ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The Examiner notes the presence of certain informalities in applicants' claims, which, while not technically being in violation of 35 U.S.C. § 112 second paragraph, are believed to clearly contain informalisms which should be corrected. For example, in each of the independent claims the language "A plaster" or "A The plaster" beginning the claims is utilized, but in all of the dependent claims the claims begin with the phrase "The plaster". Claims 2, 3 and 10 each contain either/or statements where each of the initial elements has very little, if any relationship to the element which follows. In claim 6, line 2, the utilization of "pressure-sensitive adhesive" is believed to be equivalent to "self-adhesive" which has been utilized throughout the claims and the Examiner suggests its use here as well. Additionally, other informalities may well exist and applicants are urged to correct them.

3. Claims 1-14 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More particularly, after careful consideration, applicants'

claimed language found in each of the independent claims to the fact that the claimed metallocene-polyethylene non-woven backing material is "non-adhesive" and also the additional limitation expanding on the "non-adhesive" non-woven backing found in claim 12 line 4 "wherein all of the adhesive properties of said plaster are imparted thereto" and in claim 14, last two lines wherein the "non-adhesive . . . non-woven as backing material" is characterized as "does not possess adhesive properties" are each believed to clearly violate the rule set forth in Ex parte Grasselli et al. - Board of Appeals 231 USPQ 393 affirmed CAFC 738 F. 2d 453 (Fed. Cir. 1984) to the effect that limitations such as "free of" a certain ingredient or element is new matter in the absence of an express disclosure giving support to the limitation. The various phrases referred to above are each believed to be the equivalent of "free of adhesive", and as such Grasselli et al. is clearly believed to be determinative, particularly when applicants' specification is totally devoid of any discussion whatsoever regarding the adhesive properties of the metallocene-polyethylene non-woven backing material before it is coated with adhesive. Applicants have earlier cited and strenuously argued In re Anderson, a 1973 case, in support of the proposition that "the question is not whether the added word is a word that is used in the application as filed, but whether the

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concept embodied by the added word is present in the original specification". However, as noted above in view of the total absence of any discussion regarding the adhesive properties of the non-woven backing, the Examiner can only argue that applicants' only arguments, upon careful reconsideration, are simply nothing more than a plea to over rule Grasselli et al. and allow such concepts to be included in the claims as desired. Additionally, as was earlier stated, it must be noted that In re Anderson has nothing whatsoever to do with whether proper support for negative limitations can be found in the absence of an express disclosure thereof, an issue to which Grasselli et al. is clearly directed and thus believed to be clearly on point.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR)

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system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

August 30, 2004

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~
1700

Daniel Zinker